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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/919,248	07/31/2001	John Holden Bickford	RSW920010143US1	2799

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Jack Friedman
Schneider, Olsen and Watts
3 Lear Jet Lane,Suite 201
Latham, NY 12110

EXAMINER	
PYZOCHA, MICHAEL J	
ART UNIT	**PAPER NUMBER**
2137	

DATE MAILED: 05/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/919,248	BICKFORD ET AL.	
	Examiner	Art Unit	
	Michael Pyzocha	2137	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 May 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *3-14* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *3-14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 3-14 are pending.

2. Amendment filed 05/02/2005 has been received and considered.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 13-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claims 13-14 recites the limitation "the recipient" in lines 5 and 6 of claims 13 and 14 respectively. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

6. The rejections of claims 1-2 have been withdrawn based on their cancellation.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fischer and further in view of Bando et al (US 6405244).

As per claim 3, Fischer discloses an authentication method for electronic mail, comprising the steps of: preparing electronic mail for sending from an originator to a recipient; including the authentication key in an open field of the electronic mail; and sending the electronic mail from the originator to the recipient.

Fischer fails to disclose reading from a memory an authentication key associated with the originator.

However, Bando et al teaches reading authentication information associated with the originator (see column 5 line 54 through column 6 line 6).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use Bando et al's method of reading authentication information in the email authentication method of Fischer.

Motivation to do so would have been to decide that falsification or alteration has not been performed (see Bando et al column 6 lines 1-6).

As per claim 4, the modified Fischer and Bando et al system discloses the open field is the subject line (see Fischer paragraph 25).

As per claim 5, the modified Fischer and Bando et al system discloses the authentication key associated with the originator is further associated with the recipient (see Fischer paragraph 25).

9. Claims 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over the modified Fischer and Bando et al system and further in view of Davis et al (US 5937160).

As per claim 6, the modified Fischer and Bando et al system discloses an authentication method for electronic mail, comprising the steps of: receiving electronic mail from an originator; when an authentication key is present, determining whether the authentication key is associated with the originator; and rejecting the electronic mail when the

authentication key is not associated with the originator (see Fischer and Bando et al as applied to above claims).

The modified Fischer and Bando et al system fails to disclose determining whether an authentication key is present in an open field of the electronic mail.

However, Davis et al teaches determining whether a type of information is present in an open field of the electronic mail (see column 11 lines 25-42).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use Davis et al's method of determining the presence of information in the subject field to determine if the authentication information of the modified Fischer and Bando et al system is present.

Motivation to do so would have been to allow for different actions to occur based on the information in the subject (see Davis et al column 11 lines 25-42).

As per claim 7, the modified Fischer, Bando et al and Davis et al system discloses the open field is the subject line (see Fischer paragraph 25).

As per claim 12, the modified Fischer, Bando et al, and Davis et al system discloses claimed material as applied to claims 1 and 6.

10. Claims 8-11, 13-14 rejected under 35 U.S.C. 103(a) as being unpatentable over the modified Fischer, Bando et al, and Davis et al system and further in view of MSA (post by Arthur Urbanowicz).

As per claim 8, the modified Fischer, Bando et al, and Davis et al system discloses an authentication method for electronic mail, comprising the steps of: receiving electronic mail from an originator; determining whether an authentication key is present; and rejecting the electronic mail when the authentication key is not present (see rejection of claim 12).

The modified Fischer, Bando et al and Davis et al system fails to disclose determining whether an authentication key is expected to be present; and when it is authenticate the user.

However, MSA discloses such a conditional authentication method (see page 1).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use MSA's conditional authentication method in the modified email authentication system of Fischer, Bando et al and Davis et al.

Motivation to do so would have been require un-trusted users to be authenticated (see MSA page 1).

As per claim 9, the modified Fischer, Bando et al, Davis et al and MSA system discloses an authentication method for

electronic mail, comprising the steps of: receiving electronic mail from an originator; determining whether an authentication key is expected to be present in an open field of the electronic mail; when an authentication key is expected to be present, determining whether the authentication key is present; when the authentication key is not present, rejecting the electronic mail; and when the authentication key is present, determining whether the authentication key is associated with the originator, accepting the electronic mail when the authentication key is associated with the originator, and rejecting the electronic mail when the authentication key is not associated with the originator (MSA applied to the rejection of claims 6 and 8).

As per claim 10, the modified Fischer, Bando et al, Davis et al and MSA system discloses the step of determining whether an authentication key is expected to be present in an open field of the electronic mail further includes the step of reading a memory at an address that is dependent upon a source identifier that identifies the originator (see MSA where the trusted server name is inherently stored in memory).

As per claim 11, the modified Fischer, Bando et al, Davis et al and MSA system discloses the step of determining whether the authentication key is associated with the originator further

includes the step of reading a memory at an address that is dependent upon a source identifier that identities the originator (see Bando et al column 5 line 54 through column 6 line 6).

As per claim 13, the modified Fischer, Bando et al, Davis et al and MSA system discloses an authentication method for electronic mail, comprising the steps of: receiving the electronic mail from an originator, the electronic mail having been previously prepared for sending from an originator to a recipient; determining whether an authentication key is expected to be present in an open field of the electronic mail; when an authentication key is expected to be present, determining whether the authentication key is present; and rejecting the electronic mail when the authentication key is not present in the open field of the electronic mail (see rejection of claims 12 and 9).

As per claim 14, the modified Fischer, Bando et al, Davis et al and MSA system discloses an authentication method for electronic mail having a subject line, comprising the steps of: receiving the electronic mail from an originator the electronic mail having been previously prepared for sending from an originator with a source identifier to a recipient with a destination identifier; determining whether an authentication

key is expected to be present in an open field of the electronic mail; then the authentication key is not expected to be present, accepting the electronic mail; when the authentication key is expected to be present, determining whether the authentication key is present; when the authentication key is present, determining whether the authentication key is associated with the originator and further associated with the recipient; accepting the electronic mail when the authentication key is determined to be associated with the originator and the recipient; rejecting the electronic mail when the authentication key is determined not to be associated with the originator and further associated with the recipient; and, when the authentication key is not present, rejecting the electronic mail (see rejection of above claims where it is inherent that every email has a source and destination identifier).

Response to Arguments

11. Applicant's arguments filed 05/02/2005 have been fully considered but they are not persuasive. Applicant argues: Fischer in view of Bando fails to teach of suggest the claimed limitation of "reading from a memory an authentication key associated with the originator" because of non-persuasive motivation, particularly that the steps of claim 3 are performed

by the sender of the message and not by the receiver of the message so the receiver, not the sender, gains the benefit of the given motivation and that the ability to decide that falsification or alteration has not been performed requires the ability to verify the presence of the authentication key in an open field of the electronic mail; that Fischer and Bando in view of Davies does not teach determining whether an authentication key is present in an open field because Davis does not address an authentication key; Fischer, Bando, and Davis in view of MSA does not teach the limitation of when an authentication key is expected to be present, determining whether the authentication key is present and rejecting the electronic mail when the authentication key is not present; Fischer, Bando, and Davis in view of MSA fail to teach the features of claim 9 because MSA fails to teach the features of claim 9; the inherency claimed that the trusted server name is stored in memory at an address; Bando is silent to the address of claim 11; and the inherency claimed that every email has a source and destination identifier.

Regarding Applicant's argument that Fischer in view of Bando fails to teach of suggest the claimed limitation of "reading from a memory an authentication key associated with the originator" because of non-persuasive motivation, particularly

that the steps of claim 3 are performed by the sender of the message and not by the receiver of the message so the receiver, not the sender, gains the benefit of the given motivation and that the ability to decide that falsification or alteration has not been performed requires the ability to verify the presence of the authentication key in an open field of the electronic mail, by reading the authentication key into memory and producing the authenticated messages in Bando system gains the benefit the advantages of the determination of falsification or alteration and the reading of an authentication key is done by both the sender and the receiver. Also it is not required that the authentication key be in an open field of an electronic mail message, as shown by Bando an authentication key can be made public.

Regarding Applicant's argument that Fischer and Bando in view of Davies does not teach determining whether an authentication key is present in an open field because Davis does not address an authentication key, Davis is only relied upon for its teaching of determining whether a type of information is present in an open field of an electronic mail and Fischer and Bando are relied upon for the authentication key being the information in an open field.

Regarding Applicant's argument that Fischer, Bando, and Davis in view of MSA does not teach the limitation of: when an authentication key is expected to be present, determining whether the authentication key is present and rejecting the electronic mail when the authentication key is not present, MSA teaches these limitations on page 1 number 1 (at the top of the page).

Regarding Applicant's argument that Fischer, Bando, and Davis in view of MSA fail to teach the features of claim 9 because MSA fails to teach the features of claim 9 as in claim 8 and as in claim 6 Fischer, Bando, and Davis teach the limitations except for the above discussed limitations of claim 8 which are taught in MSA as in the above argument.

Regarding Applicant's argument of the inherency claimed that the trusted server name is stored in memory at an address, if the trusted server name is not stored in memory (and all data in memory is stored at an address as seen by the definition of memory from Answers.com) then the system of Fischer, Bando, Davis and MSA would have no way of determining when a electronic mail was coming from an un-trusted network.

Regarding Applicant's argument that Bando is silent to the address of claim 11, an address is inherent to memory as in the above argument.

Regarding Applicant's argument of the inherency claimed that every email has a source and destination identifier as seen in RFC 822 each electronic mail has source and destination identifiers.

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Pyzocha whose telephone number is (571) 272-3875. The examiner

can normally be reached on 7:00am - 4:30pm first Fridays of the bi-week off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571) 272-3868. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MJP

ANDREW CALDWELL
SUPERVISORY PATENT EXAMINER